



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/790,934

03/02/2004

Jay S. Walker

03-026

3244

22927

7590

01/23/2009

WALKER DIGITAL MANAGEMENT, LLC  
2 HIGH RIDGE PARK  
STAMFORD, CT 06905

EXAMINER

DHILLON, MANJOT K

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

01/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/790,934	<b>Applicant(s)</b> WALKER ET AL.	
	<b>Examiner</b> MANJOT K. DHILLON	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/08 has been entered.

### ***Response to Amendment***

2. This office action is in response to applicant's response filed on 12/11/08. Applicant responds to rejections. Claims 1-14 and 33 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5-8, 10, 13, and 33, are rejected under 35 U.S.C. 102(b) as being anticipated by Acres et al. (US 5655961).

Concerning claim 1, Acres et al. teaches a method comprising: determining a first time; determining a second time; and providing, based on the first time matching the

Art Unit: 3714

second time, entry into a bonus game of a gaming device **[column 25, line 38- column 26, line 24]** wherein at least one attribute of the bonus game is different than the at least one attribute otherwise would be if entry to the bonus game was not provided based on the first time matching the second time **[column 25, line 38- column 26, line 24]**. **A bonus game is interpreted as a game in which enhanced bonus payouts are outputted.** Any game that awards a bonus payout is a bonus game. The mystery jackpot and bonus time jackpot have different attributes based on the method of entry.

Concerning claim 2, Acres et al. teaches a first time includes determining a reference time; and wherein determining a second time includes determining a current time **[column 25, line 38- column 26, line 24]**.

Concerning claim 5, Acres et al. teaches including determining a type of bonus game deterministically **[column 25, line 38- column 26, line 24]**.

Concerning claim 6, Acres et al. teaches determining whether a player has satisfied at least one criterion; and wherein providing includes providing, based on the first time matching the second time and the determining of whether the player has satisfied the at least one criterion, entry into the bonus game **[column 25, line 38- column 26, line 24]**.

Concerning claim 7, Acres et al. teaches determining whether a player has satisfied at least one criterion includes determining whether the player has made a specified number of handle pulls at a gaming device **[column 25, line 38- column 26, line 24]**.

Concerning claim 8, Acres et al. teaches determining whether a player has satisfied at least one criterion includes determining whether the player has made a specified number of handle pulls at a gaming device within a time interval beginning a specified period of time prior to the first time, and ending with the first time **[ column 3, lines 13-37 and column 25, line 38- column 26, line 24]**.

Concerning claim 10, Acres et al. teaches determining whether a player has satisfied at least one criterion includes determining whether the player has wagered, at a gaming device, an amount of currency whose aggregate value equals or exceeds a specified value, within a time interval beginning a specified period of time prior to the first time, and ending with the first time **[column 25, line 38- column 26, line 24]**.

Concerning claim 13, Acres et al. teaches includes providing, based on the first time matching the second time, entry into a bonus game independently of any prior outcomes generated **[column 25, line 38- column 26, line 24]**.

Concerning claim 33, Acres et al. teaches wherein the at least one attribute of the bonus game comprises at least one of a prize, a payout, and a win probability **[column 25, line 38- column 26, line 24]**.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3714

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3, 4, 8, 9, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres et al. (US 5655961).

Concerning claims 3 and 4, Acres et al. teaches determining a first time includes determining a beginning of a next hour and/or determining a time that is a predetermined number of minutes before a beginning of a next hour **[column 25, line 38- column 26, line 24]**. Acres et al. teaches the bonus time schedule can be modified to encourage gaming activity. Setting the schedule to a beginning of a next hour and minutes before a beginning of a next hour are obvious variants and considered design choice to one of ordinary skill in the art.

Concerning claims 8 and 9, Acres et al. teaches determining whether a player has satisfied at least one criterion includes determining whether the player has made a specified number of handle pulls at a gaming device within a time interval beginning a specified period of time such as one hour prior to the first time, and ending with the first time **[column 3, lines 13-37 and column 25, line 38- column 26, line 24]**. Acres et al.

Art Unit: 3714

teaches the bonus time schedule can be modified to encourage gaming activity. Setting the schedule to a beginning of a next hour and minutes before a beginning of a next hour are obvious variants and considered design choice to one of ordinary skill in the art.

Concerning claims 11, 12 and 14, Acres et al. teaches determining whether a player has satisfied at least one criterion includes determining whether the player has: paid in taxes to a gaming device, an amount of currency whose aggregate value equals or exceeds a specified value, within a time interval beginning a specified period of time prior to the first time, and ending with the first time and/or a specified average rate of play at a gaming device within a time interval beginning a specified period of time prior to the first time, and ending with the first time, and/or paid a fee to a gaming device in exchange for insurance that the player will be provided entry into a bonus game

**[column 3, lines 13-37 and column 25, line 38- column 26, line 24].** Acres et al.

teaches improved player tracking by recording each and every machine transaction including time of play, machine number, duration of play, coins in, coins out, hand paid jackpots and games played. The player tracking is conducted over the same network as the accounting data is extracted. This allows the invention to provide bonusing to certain individual players as well as during certain times. As with standard player tracking, the above-described system monitors and reports how many coins are played by each player. The system according to the invention, however, also includes the ability to record how long each player spends at each machine and the number of coins won, games played, and hand jackpots won by each player. Taxes paid to a gaming

Art Unit: 3714

device, an average rate of play and paying insurance are all obvious variants to duration of play, coins in, and hand paid jackpots and are considered design choice to one of ordinary skill in the art.

### ***Examiner's Note***

8. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

### ***Response to Arguments***

Applicant's arguments filed 12/11/08 have been fully considered but they are not persuasive. Applicant argues that Acres does not teach "providing, based on the first time matching the second time, entry into a bonus game of a gaming device wherein at least one attribute of the bonus game is different than the at least one attribute otherwise would be if entry to the bonus game was not provided based on the first time matching the second time". However, Examiner disagrees.

Entry into the Bonus Time Jackpot game is conditional upon the first time (i.e., the current time of day) matching a second time (i.e., the preset bonus time). While



Art Unit: 3714

other factors may also influence entry into the Bonus Time Jackpot game, Applicant's claims do not preclude these factors.

Acres discloses at least two bonus games – a Mystery Jackpot Game & a Bonus Time Jackpot Game. Each game has a different method of entry. The payout from the Mystery Jackpot Game is different from the Bonus Time Jackpot Game. Thus at least one attribute of the bonus games is different based on the method of entry.

Applicant argues that Acres fails to teach a bonus game. Examiner takes the position that any game that awards a bonus payout is *ipso facto* a bonus game. Thus Acres reads on the claim language, and therefore anticipates the invention.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANJOT K. DHILLON whose telephone number is (571)270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Manjot K. Dhillon  
Examiner  
Art Unit 3714

/M. K. D./  
Examiner, Art Unit 3714

/Corbett Coburn/  
Primary Examiner  
AU 3714